

**PATENT****Application # 09/703,699****Attorney Docket # 2000-0020 (1014-068)****REMARKS**

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1, 2, 4-7, and 9 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-20 are now pending in this application. Each of claims 1, 5, and 9 are in independent form.

**I. The Written Description Rejections**

Each of claims 1-20 was rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. These rejections are respectfully traversed.

The rejection states, at Page 4, that:

[t]he claims contain new subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The examiner was unable to find any support in either the originally filed specification or the originally filed drawings for the limitations "the

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first router directly interconnected by a first plurality of data paths to a first sub-plurality of interconnected routers from the plurality of interconnected routers” or “the second router directly interconnected by a second plurality of data paths to a second sub-plurality of interconnected routers from the plurality of interconnected routers”. If applicant believes that the originally filed specification or the originally filed drawings support this combination of limitations, examiner respectfully requests that the specific page and line numbers be supplied in the response to this office action.

Applicant respectfully submits that one of ordinary skill in the art would find more than adequate descriptive support for the claim amendments at least in FIG. 1 and/or at page 1, lines 9-22. It is respectfully submitted that no new matter has been introduced. Thus, reconsideration and withdrawal of each of these rejections is respectfully requested.

**II. The Obviousness Rejections**

Each of claims 1-20 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of Lockhart (U.S. Patent No. 6,189,035), Albert (U.S. Patent No. 6,549,516), Jain (U.S. Patent No. 5,491,801), Camon (U.S. Patent No. 6,754,715), and/or Teraslinna (U.S. Patent No. 5,706,279). These rejections are respectfully traversed.

**A. Inherency**

Inherency “requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).

The present Office Action recites that:

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1. "storing said count of IP data packets in a memory device for subsequent processing (**inherent** as the recent packet count is used at a later time (e.g.step64))". *See* Page 6.
2. "[r]egarding claim 2, Lockhart discloses the steps of: reading said count of IP data packets from said memory device (**inherent** in step 64 of Figure 4; the recent packet count must be read before it can be evaluated)". *See* Page 7.
3. "[r]egarding claim 14, Lockhart clearly discloses the threshold as described above. It is **inherent** that this threshold must be determined, thus disclosing the limitation of claim 14." *See* Page 8.
4. "storing said count of IP data packets sent to a particular IP destination address in a memory device for subsequent processing (**inherent** as the recent packet count is used at a later time)". *See* Page 10.
5. "[r]egarding claim 6, with the parent claims addressed by Lockhart as modified above, Lockhart discloses the limitations of d. reading said count of IP data packets from said memory device (**inherent** in step 64 of Figure 4; the recent packet count must be read before it can be evaluated)". *See* Page 12.
6. "[r]egarding claim 20, Lockhart clearly discloses the threshold as described above. It is **inherent** that this threshold must be determined, thus disclosing the limitation of claim 14." *See* Page 13.

As an initial matter, Applicant respectfully requests clarification regarding why the rejection of claim 20 is justified based upon the alleged disclosed "limitation of claim 14".

Further, no evidence has been presented that the admittedly "missing descriptive material is necessarily present" in Lockhart. Applicants respectfully request provision of evidence supporting these six assertions or withdrawal of the rejections of the corresponding claims.

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None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *See* MPEP 2143.

Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

**C. Missing Claim Limitations – Claims 1 and 5**

Each of independent claims 1 and 5 recite, yet the applied portions of Lockhart fail to teach or suggest, either expressly or inherently, *inter alia*, "tabulating at said first router a plurality of source counts of IP data packets, each source count of IP data packets of said plurality of source counts of IP data packets indicative of a count of packets received from a particular IP source during a first time interval, said plurality of source counts of IP data packets associated with every source that provides IP data packets to said first router."

Instead, Lockhart allegedly recites, "determining whether an incoming data packet is on a list of selected (trusted) sources, and, if not on the selected list, rejecting the data packet if the number of data packets from that source is greater than a threshold number."

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Each of independent claims 1 and 5 recite, yet the applied portions of Lockhart fail to teach or suggest, either expressly or inherently, *inter alia*, “tabulating at said first router a **plurality of destination counts of IP data packets**, each destination count of IP data packets of said plurality of destination counts of IP data packets indicative of a count of packets routable to a particular IP destination address during said first time interval.”

The present Office Action correctly asserts that “Lockhart does not disclose expressly the limitation that the count value is ... a count of packets associated with a given destination”, yet erroneously alleges that “in figures 11 and 12, Tersalinna discloses a method of inhibiting the packet flow **based on the traffic destined to a particular endpoint.**” See Page 11. Instead of teaching or suggesting this alleged subject matter, Tersalinna, at col. 16, lines 35-54, allegedly recites, regarding Figure 12:

FIG. 12 is a flow chart of an embodiment of a method of controlling a flow of packets being forwarded by a customer premises equipment to an endpoint of a fast packet switching network. The fast packet switching network has a plurality of virtual connections provisioned from **the [source] endpoint** to a plurality of destination endpoints, wherein the virtual connections are utilized for communicating the packets to the destination endpoints. The packets provided by the customer premises equipment are stored in a queue, and presented to **the [source] endpoint** in accordance with the following method. As indicated by block 150, the method includes a step of **obtaining a parameter indicative of bandwidth usage associated with the [source] endpoint** over at least two of the virtual connections. The parameter provides a measure of bandwidth usage associated with a bundle of provisioned virtual connections which include the at least two of the virtual connections. As previously mentioned, the parameter may be a measure of average bit rate or peak bit rate, and may be computed using a leaky bucket algorithm.

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Applicant respectfully asks where, “tabulating at said first router a **plurality of destination counts of IP data packets**, each destination count of IP data packets of said plurality of destination counts of IP data packets indicative of a count of packets routable to a particular IP destination address during said first time interval”?

The applied portions of the other applied references fail to cure at least these deficiencies of the applied portions of Lockhart and/or Tersalinna.

Accordingly, Applicant respectfully requests withdrawal of each of the rejections of claim 1 and claim 5.

**D. Missing Claim Limitations – Claim 9**

Independent claim 9 recites, yet the applied portions of Lockhart fail to teach or suggest, either expressly or inherently, *inter alia*, “said plurality of source counts of IP data packets associated with every source that provides IP data packets to said first router.”

Instead, as stated above, Lockhart allegedly recites, “determining whether an incoming data packet is on a list of **selected (trusted) sources**, and, if not on the selected list, rejecting the data packet if the number of data packets from that source is greater than a threshold number.”

Independent claim 9 recites, yet the applied portions of Tersalinna fail to teach or suggest, either expressly or inherently, *inter alia*, “each destination count of IP data packets of said plurality of destination counts of IP data packets indicative of a count of packets routable to a particular IP destination address during said first time interval.”

As demonstrated above, in section II.C. Tersalinna does not teach or suggest, either expressly or inherently, a “plurality of destination counts”. The applied portions of the other applied references fail to cure at least these deficiencies of the applied portions of Tersalinna. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 9.

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Each of claims 11 and 17 recite, yet the applied portions of Albert fail to teach or suggest, either expressly or inherently, *inter alia*, **“providing said time-based data traffic measure to a user via a user interface.”**

Instead, Albert allegedly recites “[f]orwarding agent 250 also includes a user interface 256 that allows a user to configure the forwarding agent or monitor operation of the forwarding agent.” Applicant respectfully asks, where does this relied upon passage teach or suggest, either expressly or inherently, **“providing said time-based data traffic measure to a user via a user interface”**? Applicant respectfully submits that the mere presence of a “user interface” in Albert does not teach or suggest the claimed subject matter.

The applied portions of the other applied references fail to cure at least these deficiencies of the applied portions of Albert. Accordingly, Applicant respectfully requests withdrawal of each rejection of claims 11 and 17.

**F. Motivation or Suggestion To Combine References – Claims 11 and 17**

“The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” MPEP 2142. According to the Federal Circuit the “mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the **desirability** of the modification.” *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992) (citing *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (emphasis added)). In that same case, the Federal Circuit further held that it “is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’” *Id.*, 23 USPQ 2d at 1784.

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Instead, **“obviousness requires proof that the skilled artisan . . . would select the elements from the cited prior art references for combination in the manner claimed”**. *In re Scott E. Johnston* (Fed. Cir. 30 January 2006) (quoting *In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998) (emphasis added)). To make that proof, the Office Action must present sufficient evidence of some **“suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”**:

1. **“select the references”**;
2. **“select the teachings of [the] separate references”**; and
3. **“combine [those teachings] in the way that would produce the claimed invention”**.

*Id.* See also *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998) (discussing the **“the test of whether it would have been obvious to select specific teachings and combine them as did the applicant”**) (emphasis added); and *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985) (**“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”**).

Moreover, **“[w]hen determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.”** *Akamai Techs. v. Cable & Wireless Internet Servs.*, 344 F.3d 1186, 68 USPQ 2d 1186 (Fed. Cir. 2003) (emphasis added).

Regarding each of claims 11 and 17, the present Office Action recites, regarding the proffered combination of Albert with other references, that the **“motivation for doing so would have been to provide the customer with greater visibility into the behavior of the system.”** See Page 7; Page 13.



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Thus, the Office Action presents **no evidence of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" to obtain the claimed subject matter of claims 11 and 17. Moreover, the Office Action presents **no evidence** of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed invention".

Thus, the Office Action fails to present the required **proof** of obviousness.

Consequently, Applicant respectfully requests withdrawal of the obviousness rejections of claims 11 and 17.

**G. Obviousness Summary**

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach or suggest **every** limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

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A potential statement of reasons for the indication of allowable subject matter is:

“none of the reference of record, alone or in combination, teach or suggest the combination of limitations found in the independent claims. Namely,

claims 1-8 are allowable because none of the references of record, alone or in combination, teach or suggest ‘tabulating at said first router a plurality of source counts of IP data packets, each source count of IP data packets of said plurality of source counts of IP data packets indicative of a count of packets received from a particular IP source during a first time interval, said plurality of source counts of IP data packets associated with every source that provides IP data packets to said first router; tabulating at said first router a plurality of destination counts of IP data packets, each destination count of IP data packets of said plurality of destination counts of IP data packets indicative of a count of packets routable to a particular IP destination address during said first time interval’; and

claims 9-20 are allowable because none of the references of record, alone or in combination, teach or suggest ‘the time-based data traffic measure based upon at least one of a source count of a plurality of source counts or a destination count of a plurality of destination counts, each source count of IP data packets of said plurality of source counts of IP data packets indicative of a count of packets received from a particular IP source during a first time interval, each destination count of IP data packets of said plurality of destination counts of IP data packets indicative of a count of packets routable to a particular IP destination address during said first time interval, each of said plurality of source counts and said plurality of destination counts tabulated and stored at the first router, said

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plurality of source counts of IP data packets associated with every source that provides IP data packets to said first router”.

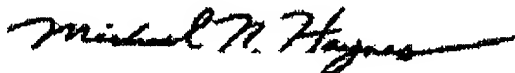
**CONCLUSION**

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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